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**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 11  
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Emerson Electric Company

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Serial No. 75/494,057

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Anthony Martin of Harness, Dickey & Pierce for Emerson Electric Company.

Won T. Oh, Trademark Examining Attorney, Law Office 104.

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Before Cissel, Quinn and Drost, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 1, 1998, applicant filed the above-referenced application to register the mark "MONTEREY" on the Principal Register for "electric fans and parts therefor," in Class 11. The basis for the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these products.

This case is now before the Board on appeal from the September 13, 2000 final refusal to register based on Section 2(d) of the Lanham Act. The Examining Attorney

maintains that if applicant were to use the mark "MONTEREY" in connection with "electric fans not having associated electric lighting fixtures, and parts therefor," as the application was subsequently amended to identify the goods with which applicant intends to use the mark, confusion would be likely in view of the prior registration of the same mark, "MONTEREY," for "electric lighting fixtures for indoor and outdoor use," in Class 11.<sup>1</sup>

Both applicant and the Examining Attorney filed briefs on appeal, but applicant did not request an oral hearing before the Board.

Based on careful consideration of the record and the arguments presented in the briefs, we find that the refusal to register is well taken.

The factors to be considered in determining whether confusion would be likely were set forth by the predecessor to our primary reviewing court in *In re E. I. duPont de Nemours*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Chief among those factors are the similarities between the marks and the relatedness of the goods with which the marks are, or are intended to be, used. If the marks are identical,

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<sup>1</sup> Reg. No, 2,292,967, issued on the Principal Register to Alpan, Inc. on November 16, 1999. The registration claims use since August of 1996.

the relationship between the goods in question does not need to be as close to support a finding that confusion would be likely as would be the case if there were differences between the marks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70 (TTAB 1981). Any doubts as to whether confusion would be likely must be resolved in favor of the prior user and registrant. In *re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988).

In the instant case, confusion would clearly be likely if applicant were to use the mark it seeks to register. Applicant's mark is identical to the registered mark, and the goods set forth in the application, as amended, are commercially related to those specified in the cited registration in such a way that the prospective purchasers would be likely to view the use of the same mark on both products as an indication of common source.

In support of the refusal to register, the Examining Attorney made of record a copy of a page from the Northern Virginia Yellow Pages directory wherein there appear several advertisements for businesses which offer both electric fans and lighting products. This evidence indicates that purchasers of these goods have reason to expect both fans and lights to be available from the same

place. Additionally, the Examining Attorney made of record a large number of third-party federal trademark registrations based on use wherein the goods listed include both electric fans and lighting fixtures. Such registrations serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. In re Albert Trostel & Sons, 29 USPQ2d 1783 (TTAB 1993); In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467 (TTAB 1988). Together with the directory mentioned above, the evidence submitted by the Examining Attorney establishes that the goods specified in the application are related to those set forth in the cited registration in such a manner that the use of the same mark in connection with both would be likely to cause confusion.

Applicant's arguments to the contrary are not well taken. Applicant argues that the existence of a number of third-party registrations for the mark "MONTEREY" show that confusion is not likely in this case. As the Examining Attorney notes, however, the registration information submitted by applicant does not show that any of these registrations lists goods of the type identified in either this application or the cited registration. That the same mark may be registered for goods such as "prefabricated shower receptors," "bathing suits," "shingles for building

purposes," "sheets and pillowcases" and "knocked-down metal awnings and parts therefor" is irrelevant to our inquiry in the instant case. Applicant has not shown that the mark it seeks to register is weak in connection with the goods involved in this appeal.

In summary, confusion is likely because the mark applicant seeks to register is identical to the cited registered mark and the goods with which applicant intends to use this mark are commercially related to those set forth in the cited registration such that prospective purchasers would expect the use of the same mark on both products to indicate that they emanate from the same source. Accordingly, the refusal to register under Section 2(d) of the Lanham Act is affirmed.

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